

REMARKS

Applicants thank the Examiner for extending the time to discuss the above case with applicants' representative Li Su today.

During the discussion, Examiner Shailendra agreed to withdraw the finality of the Final Rejection. As discussed, regarding the newly cited prior art Hurd et al, the rejection is based on subject matter (R_b as aryl) that was originally claimed in the application as filed. Therefore, the new grounds of rejection was not necessitated by applicants amendment (amended the embodiment alkyl to C_2 - C_4 alkyl in R_b).

Examiner Shailendra also agreed to rejoin claims 9-29, 35-37 in view of the 11/29/2010 Restriction Requirement, which stated that applicants were required to elect a single species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable; the Examiner also stated that if the product claims are found allowable, withdrawn process claims that depend from will be considered for rejoinder. In view of the below amendments, which renders the generic claims allowable, claims 9-29, 35-37 should be rejoined.

Applicants have amended claim 1 to replace "aryl" with "naphthyl". Support can be found in claim 2 as originally filed. Applicant have also amended claim 5 to depend from claim 4 and deleted an embodiment. Applicants have added claim 38. Support can be found in claim 2 as originally filed. Applicants have also cancelled claim 19. No new matter is added.

Claim Rejections – 35 USC § 102

The Examiner has rejected claims 1-3 and 28 under 35 U.S.C. § 102(b) as being anticipated by Hurd et al (J.Org. Chem), which has R_b as phenyl. The Examiner has also objected to claims 4-6, 33-34 and 36 as being dependent upon a rejected base claim. The Examiner also contends that claim 33 requires the deletion of some compounds that do not read on the elected subject matter.

Applicants disagree with the Examiner's rejection since Hurd et al. does not state that the $Ph-C(O)-O-NH-C(O)-CH_2CH_2-$ is a residue of a histone deacetylase inhibitor, as recited by claim 1. However, to advance prosecution, Applicants have amended claim 1 to replace "aryl" with "naphthyl", thereby overcoming the rejection. Pursuant to the Supplemental Amendment filed on June 8, 2011, claim 4 is independent, and claims 33-36 depend from claim 4, and are not dependent from rejected claim 1. Further, the compounds of claim 33 fall within the scope of claim 4, and thus no deletions are required.

Applicants request withdrawal and reconsideration of the above rejection.

If a telephonic communication with the Applicants' representative will advance the prosecution of the instant application, please telephone the representative indicated below. Applicants believe no additional fees are due but the Commissioner is authorized to charge any fees required in connection with this amendment to Merck Deposit Account No. 13-2755.

Respectfully submitted,

By: /Li Su, Reg. # 45,141/

Li Su
Registration No. 45,141
Attorney for Applicants

Merck & Co., Inc.
PO Box 2000 - RY 60-30
Rahway, New Jersey 07065-0907
Telephone No. (732) 594-5455

Date: November 28, 2011